

## REMARKS

In accordance with the foregoing, claims 1-7 have been amended, and new claims 8 and 9 have been added. Claims 1-9 are pending, with claim 1 being independent. No new matter is presented in this Amendment.

### Request for Interview Prior to Issuance of Next Office Action

As discussed in detail below, claims 1-7 have been rejected under 35 USC 102(e) as being anticipated by various ones of claims 1-5, 7, 25, and 27-30 of Lamkin et al. (Lamkin '729) (U.S. Patent Application Publication No. 2005/0278729), which was filed on July 12, 2005, as a continuation of an earlier application. However, claims 1-5, 7, 25, and 27-30 of Lamkin '729 were copied from two of the applicants' copending applications, and are not supported by the earlier application of which Lamkin '729 purports to be a continuation. Thus, Lamkin '729 in fact is a continuation-in-part of the earlier application, and the effective U.S. filing date of claims 1-5, 7, 25, and 27-30 of Lamkin '729 is July 12, 2005, which is after the U.S. filing date of October 16, 2003, of the present application, such that various ones of claims 1-5, 7, 25, and 27-30 of Lamkin '729 cannot anticipate claims 1-7 of the present application as alleged by the Examiner. However, should the Examiner disagree, it is respectfully requested that the Examiner contact the undersigned attorney to schedule an interview to discuss this matter prior to issuing the next Office Action.

### Drawing Objections

FIGS. 1, 2, and 12 have been objected to as failing to conform to 37 CFR 1.84(p)(1) and 37 CFR 1.84(q), and FIGS. 2 and 12 have been objected to as failing to conform to 37 CFR 1.84(p)(3). However, the Examiner did not identify the alleged deficiencies in FIGS. 1, 2, and 12 that make these figures fail to comply with the portions of 37 CFR 1.84 referred to by the Examiner, thereby making it impossible for the applicants to respond to the objection without speculating about what changes to FIGS. 1, 2, and 12 the Examiner considers to be necessary to overcome the objection.

37 CFR 1.84(p)(1) provides as follows:

(1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must not be used in association with brackets or inverted commas, or enclosed within outlines, *e.g.*, encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet. Reference characters should be arranged to follow the profile of the object depicted.

37 CFR 1.84(p)(3) provides as follows:

(3) Numbers, letters, and reference characters must measure at least .32 cm. (1/8 inch) in height. They should not be placed in the drawing so as to interfere with its comprehension. Therefore, they should not cross or mingle with the lines. They should not be placed upon hatched or shaded surfaces. When necessary, such as indicating a surface or cross section, a reference character may be underlined and a blank space may be left in the hatching or shading where the character occurs so that it appears distinct.

37 CFR 1.84(q) provides as follows:

(q) *Lead lines.* Lead lines are those lines between the reference characters and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference character and extend to the feature indicated. Lead lines must not cross each other. Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake. Lead lines must be executed in the same way as lines in the drawing. See paragraph (l) of this section.

As can be seen, 37 CFR 1.84(p)(1), 37 CFR 1.84(p)(3), and 37 CFR 1.84(q) contain many different requirements. Accordingly, it is respectfully requested that the Examiner identify the alleged deficiencies in FIGS. 1, 2, and 12 that make these figures fail to comply with these portions of 37 CFR 1.84 so that the applicants can respond to the objection without speculating about what changes to FIGS. 1, 2, and 12 the Examiner considers to be necessary to overcome the objection.

## Double Patenting Rejections

### Rejection 1

Claim 1 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/685,694. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because the apparatus, which includes a buffer, of claim 1 of the copending application [No. 10/685,694] anticipates the data storage medium of claim 1 [of the present application]."

However, claim 1 of the present application recites "[a] computer-readable medium having recorded thereon: audio video (AV) data; a markup document which was provided to reproduce the AV data in an interactive mode; and control information which was provided to identify buffering state information of the markup document to be preloaded," while claim 1 of copending application No. 10/685,694 recites "[a]n apparatus for reproducing AV data using a markup document in an interactive mode, comprising: a buffer which buffers the markup document; a content decoder which interprets the markup document; and a buffer manager which manages the buffer to preload the markup document and informs the content decoder of whether preloading of the markup document is completed," such that claim 1 of copending application No. 10/685,694 does not anticipate claim 1 of the present application as alleged by the Examiner.

Furthermore, it is submitted that the Examiner's explanation of this rejection does not comply with the requirements of an obviousness-type double patenting rejection set forth in MPEP 804(II)(B)(1), which provides as follows in pertinent part on MPEP pages 800-21 and 800-22 (emphasis by underlining added):

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art; and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations. Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.

Here, the Examiner's explanation of this rejection does not make clear the differences between claim 1 of copending Application No. 10/685,694 and claim 1 of the present application, or the reasons why a person of ordinary skill in the art would conclude that the invention defined in claim 1 of the present application is anticipated by claim 1 of copending Application No. 10/685,694. Accordingly, it is submitted that the Examiner has not established a *prima facie* case of obviousness-type double patenting with respect to this rejection.

**Substantially the above arguments were also presented on pages 4-6 of the Amendment of March 9, 2007, but the Examiner did not take note of these arguments and answer the substance of them in the Office Action of June 5, 2007, as required by MPEP 707.07(f). Rather, the Examiner merely added the phrase "the apparatus, which includes a buffer, of" to the explanation of the rejection.**

For at least the foregoing reasons, it is respectfully requested that the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/685,694 be withdrawn.

## Rejection 2

Claim 1 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/685,696. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the copending application [No. 10/685,696] anticipates the data storage medium of claim 1 [of the present application]," and that "[a]lthough it is not specifically recited in claim 1 of the copending application, the information must be stored if a program can output it."

However, claim 1 of the present application recites "[a] computer-readable medium having recorded thereon: audio video (AV) data; a markup document which was provided to reproduce the AV data in an interactive mode; and control information which was provided to identify buffering state information of the markup document to be preloaded," while claim 1 of copending application No. 10/685,696 recites "[a] data storage medium encoded with program codes for enabling a method of reproducing AV data in an interactive mode using markup documents, performed by a computer, the data storage medium comprising: a first program code to carry out buffering of the markup documents to preload the markup documents; and a second program code to output information indicating whether the buffering of the markup documents is completed," such that claim 1 of copending application No. 10/685,696 does not anticipate claim 1 of the present application as alleged by the Examiner.

Furthermore, it is submitted that the Examiner has not established a *prima facie* case of obviousness-type double patenting with respect to this rejection at least for the same reasons discussed above in connection with the first obviousness-type double patenting rejection based on copending Application No. 10/685,694.

**Substantially the above arguments were also presented on pages 6 and 7 of the Amendment of March 9, 2007, but the Examiner did not take note of these arguments and answer the substance of them in the Office Action of June 5, 2007, as required by MPEP 707.07(f). Rather, the Examiner merely added the phrase "[a]lthough it is not specifically recited in claim 1 of the copending application, the information must be stored if a program can output it" to the explanation of the rejection.**

For at least the foregoing reasons, it is respectfully requested that the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/685,696 be withdrawn.

### Rejection 3

Claim 1 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/685,697. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because claim 17 of the copending application [No. 10/685,697] anticipates the data storage medium of claim 1 [of the present application]," and "[s]ee the rejection involving copending Application No. 10/685,696 above."

However, claim 1 of the present application recites "[a] computer-readable medium having recorded thereon: audio video (AV) data; a markup document which was provided to reproduce the AV data in an interactive mode; and control information which was provided to identify buffering state information of the markup document to be preloaded," while claim 17 of copending application No. 10/685,697 recites "[a]computer readable medium encoded with operating instructions for implementing a method of reproducing AV data in an interactive mode using markup document, performed by a computer, the method comprising: buffering the markup document to preload the markup document; and outputting buffering state information of the markup document in response to a report signal," such that claim 17 of copending application No. 10/685,697 does not anticipate claim 1 of the present application as alleged by the Examiner.

Furthermore, it is submitted that the Examiner has not established a *prima facie* case of obviousness-type double patenting with respect to this rejection at least for the same reasons discussed above in connection with the first obviousness-type double patenting rejection based on copending Application No. 10/685,694.

**Substantially the above arguments were also presented on pages 7 and 8 of the Amendment of March 9, 2007, but the Examiner did not take note of these arguments and answer the substance of them in the Office Action of June 5, 2007, as required by MPEP**

**707.07(f).** Rather, the Examiner merely added the phrase "[s]ee the rejection involving copending Application No. 10/685,696 above" to the explanation of the rejection. In the rejection involving copending Application No. 10/685,696, the Examiner merely added the phrase "[a]lthough it is not specifically recited in claim 1 of the copending application, the information must be stored if a program can output it" to the explanation of the rejection.

For at least the foregoing reasons, it is respectfully requested that the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/685,697 be withdrawn.

#### Rejection 4

Claim 1 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10/685,699. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 of the copending application [No. 10/685,699] anticipates the data storage medium of claim 1 [of the present application]," and "[s]ee the rejection involving copending Application No. 10/685,696 above."

However, claim 1 of the present application recites "[a] computer-readable medium having recorded thereon: audio video (AV) data; a markup document which was provided to reproduce the AV data in an interactive mode; and control information which was provided to identify buffering state information of the markup document to be preloaded," while claim 9 of copending application No. 10/685,699 recites "[a] computer readable medium encoded with operating instructions for implementing a method of reproducing AV data in an interactive mode using markup document, performed by a computer, the method comprising: inquiring whether preloading of the markup document is completed using an application program interface (API); and receiving a return value of true in response to the preloading of the markup document being completed and a return value of false in response to the preloading of the markup document being not completed," such that claim 9 of copending application No. 10/685,699 does not anticipate claim 1 of the present application as alleged by the Examiner.

Furthermore, it is submitted that the Examiner has not established a *prima facie* case of obviousness-type double patenting with respect to this rejection at least for the same reasons discussed above in connection with the first obviousness-type double patenting rejection based on copending Application No. 10/685,694.

Substantially the above arguments were also presented on pages 8 and 9 of the Amendment of March 9, 2007, but the Examiner did not take note of these arguments and answer the substance of them in the Office Action of June 5, 2007, as required by MPEP 707.07(f). Rather, the Examiner merely added the phrase "[s]ee the rejection involving copending Application No. 10/685,696 above" to the explanation of the rejection. In the rejection involving copending Application No. 10/685,696, the Examiner merely added the phrase "[a]lthough it is not specifically recited in claim 1 of the copending application, the information must be stored if a program can output it" to the explanation of the rejection.

For at least the foregoing reasons, it is respectfully requested that the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10/685,699 be withdrawn.

#### Rejection 5

Claim 1 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/686,521. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because claim 9 of the copending application [No. 10/686,521] anticipates the data storage medium of claim 1 [of the present application]," and "[s]ee the rejection involving copending Applications 10/685,694 and 10/685,696 above."

However, claim 1 of the present application recites "[a] computer-readable medium having recorded thereon: audio video (AV) data; a markup document which was provided to reproduce the AV data in an interactive mode; and control information which was provided to identify buffering state information of the markup document to be preloaded," while claim 1 of copending application No. 10/686,521 recites "[a]n apparatus for reproducing audio video (AV)



data using a markup document in an interactive mode, comprising: a buffer which buffers the markup document; and a buffer manager which manages the buffer to preload the markup document and outputs buffering state information of the buffer in response to a report signal," such that claim 1 of copending application No. 10/686,521 does not anticipate claim 1 of the present application as alleged by the Examiner.

Furthermore, it is submitted that the Examiner has not established a *prima facie* case of obviousness-type double patenting with respect to this rejection at least for the same reasons discussed above in connection with the first obviousness-type double patenting rejection based on copending Application No. 10/685,694.

**Substantially the above arguments were also presented on pages 9 and 10 of the Amendment of March 9, 2007, but the Examiner did not take note of these arguments and answer the substance of them in the Office Action of June 5, 2007, as required by MPEP 707.07(f).** Rather, the Examiner merely added the phrase "[s]ee the rejection involving copending Applications 10/685,694 and 10/685,696 above" to the explanation of the rejection. In the rejection involving copending Application No. 10/685,694, the Examiner merely added the phrase "the apparatus, which includes a buffer, of" to the explanation of the rejection. In the rejection involving copending Application No. 10/685,696, the Examiner merely added the phrase "[a]lthough it is not specifically recited in claim 1 of the copending application, the information must be stored if a program can output it" to the explanation of the rejection.

For at least the foregoing reasons, it is respectfully requested that the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/686,521 be withdrawn.

#### Claim Rejections Under 35 USC 101

Claim 1 has been rejected under 35 USC 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states as follows:

The data storage medium appears to store only nonfunctional descriptive material. See MPEP 2106.01.

MPEP 2106.01 referred to by the Examiner provides as follows in pertinent part on MPEP page 2100-17:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)(discussing patentable weight of data structure limitations in the context of a statutory claim to a data structure stored on a computer readable medium that increases computer efficiency) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory).

Here, it is submitted that the following features of claims 1-7 impart functionality when employed as a computer component, such that claims 1-7 do in fact recite functional descriptive material pursuant to MPEP 2106.01: "a markup document which was provided to reproduce the AV data in an interactive mode" and "control information which was provided to identify buffering state information of the markup document to be preloaded" as recited in claim 1; "an application program interface (API) that generates a report signal used to identify a buffering state of the markup document" as recited in claim 2; "an [obj].isCached(URL, resType) API that generates a report signal, where the URL is a parameter indicating a file path of the markup document and the resType is a parameter indicating an attribute of the markup document" as recited in claim 3; "an API that returns a value of 0 in response to preloading of the markup document being

successful, a value of 1 in response to the preloading of the markup document being failed, and a value of 2 in response to the preloading of the markup document still being conducted" as recited in claim 4; "an API that generates a fetch signal used to issue a command to preload the markup document" as recited in claim 5; the feature "wherein the API returns a response indicating whether the command to preload the markup document has been successfully transmitted using the fetch signal" recited in claim 6; and the feature "wherein the control information includes an API that is used to determine whether preloading of the markup document is completed" recited in claim 7.

Furthermore, in accordance with the guidelines set forth in MPEP 2106.01, independent claim 1 has been amended to recite "[a] computer-readable medium having recorded thereon . . . .," and dependent claims 2-7 have been amended to recite [t]he computer-readable medium of claim . . . ."

For at least the foregoing reasons, it is submitted that claims 1-7 recite functional descriptive material that is recorded on a computer-readable medium, and thus are directed to statutory subject matter under 35 USC 101 pursuant to MPEP 2106.01. Accordingly, it is respectfully requested that the rejection of claim 1 under 35 USC 101 be withdrawn.

#### Claim Rejections Under 35 USC 102

Claims 1-7 have been rejected under 35 USC 102(e) as being anticipated by Lamkin et al. (Lamkin '729) (U.S. Patent Application Publication No. 2005/0278729). This rejection is respectfully traversed.

In explaining the rejection, the Examiner states as follows:

Claim 1 is taught by claim 1 of Lamkin.

Claim 2 is taught by claims 1 – 3 of Lamkin.

Claim 3 is taught by claims 1 and 7 of Lamkin.

Claim 4 is taught by claims 1 and 5 of Lamkin.

Claim 5 is taught by claims 25 and 27 – 29 of Lamkin.

Claim 6 is taught by claims 25 and 27 – 30 of Lamkin.

Claim 7 is taught by claims 1 – 4 of Lamkin.

Attached to the Amendment of March 9, 2007, are copies of a Utility Patent Application Transmittal, a Fee Transmittal, and a Notice of Copied Claims Under 37 C.F.R. § 1.604(b) filed on July 12, 2005, in Lamkin '729. As can be seen from the Notice of Copied Claims, claims 1-24 of Lamkin '729 are identical to claims 1-24 of copending Application 10/686,521 because Lamkin '729 copied claims 1-24 of copending Application No. 10/686,521 as claims 1-24 of Lamkin '729. The inventors of the present application are also the inventors of copending Application No. 10/686,521. Copending Application No. 10/686,521 is referred to by its publication number of 2004/0139394 in the Notice of Copied Claims.

Also, as can be seen from the Notice of Copied Claims, claims 25-33 of Lamkin '729 are identical to claims 1-9 of copending Application No. 10/685,694 because Lamkin '729 copied claims 1-9 of copending Application No. 10/685,694 as claims 25-33 of Lamkin '729. The inventors of the present application are also the inventors of copending Application No. 10/685,694. Copending Application No. 10/685,694 is referred to by its publication number of 2004/0139249 in the Notice of Copied Claims.

The actual U.S. filing date of Lamkin '729 is July 12, 2005, which is after the U.S. filing date of October 16, 2003, of both of copending Application Nos. 10/686/521 and 10/685,694. Lamkin purports to be a continuation of Application No. 09/935,756 filed on August 21, 2001, which was published as U.S. Patent Application Publication No. 2002/0078144 to Lamkin et al. (Lamkin '144). However, it is submitted that copied claims 1-33 of Lamkin '729 appear to contain new matter with respect to parent Application No. 09/935,756 of Lamkin '729 at least because the terms "buffer manager," "report signal," and "preload" (in all its forms) recited in various ones of claims 1-24 of copending Application No. 10/686,521 and various ones of claims 1-9 of copending Application No. 685,694 appear only in various ones of copied claims 1-33 of Lamkin '729 and do not appear elsewhere in Lamkin '729 or anywhere in Lamkin '144 which is a publication of parent Application No. 09/935,756 of Lamkin '729. In light of this, it is submitted that Lamkin '729 is actually a continuation-in-part of parent Application No. 10/935,756 of Lamkin '729.

In any event, it is submitted that the Examiner cannot rely on any matter in Lamkin '729 (U.S. filing date of July 12, 2005) that does not appear in Lamkin '144 (U.S. filing date of August 21, 2001) which is a publication of parent Application No. 09/935,756 of Lamkin '729 because any such matter in Lamkin '729 has a U.S. filing date of July 12, 2005, which is after the U.S.

filing date of October 16, 2003, of the present application. In particular, the Examiner cannot rely on any of claims 1-33 of Lamkin '729 to reject any of claims 1-7 of the present application because claims 1-33 of Lamkin '729 have a U.S. filing date of July 12, 2005, which is after the U.S. filing date of October 16, 2003, of the present application.

In light of this, it is submitted that the appropriate course of action would be for the Examiner to rely on Lamkin '144 to avoid the possibility of relying on any matter in Lamkin '729 that has a U.S. filing date of July 12, 2005. Accordingly, should the Examiner be inclined to continue to rely on Lamkin '729 in the next Office Action, it is respectfully requested that the Examiner rely on Lamkin '144 instead. Alternatively, should the Examiner decline to do this, it is respectfully requested that the Examiner specifically point out where any portions of Lamkin '729 relied on by the Examiner can also be found in Lamkin '144.

In any event, since the Examiner relied only on claims 1-5, 7, 25, and 27-30 of Lamkin '729 in the rejection of claims 1-7 under 35 USC 102(e) as being anticipated by Lamkin '729, and since claims 1-7 of Lamkin '729 have a U.S. filing date of July 12, 2005, which is after the U.S. filing date of October 16, 2003, of the present application, it is respectfully requested that the rejection of claims 1-7 under 35 USC 102(e) as being anticipated by various ones of claims 1-5, 7, 25, and 27-30 of Lamkin '729 be withdrawn.

**The above arguments were also presented on pages 11 and 12 of the Amendment of March 9, 2007, but the Examiner did not take note of these arguments and answer the substance of them in the Office Action of June 5, 2007, as required by MPEP 707.07(f). Rather, the Examiner merely stated as follows on page 2 of the Office Action of June 5, 2007:**

Regarding Lamkin, the application was filed as a continuation.

However, the above arguments presented on pages 11 and 12 of the Amendment of March 9, 2007, already address the fact that Lamkin '729 purports to be a continuation, but argue that Lamkin '729 is actually a continuation-in-part. The Examiner has simply ignored these arguments in the Office Action of June 5, 2007.

The Examiner's position appears to be that since Lamkin '729 (the child Lamkin '729) was filed as a continuation of Application No. 09/935,756 filed on August 21, 2001, which was published as Lamkin '144 (the parent Lamkin '144), then copied claims 1-33 of the child Lamkin

'729 are automatically entitled to the filing date of August 21, 2001, of the parent Lamkin '144. However, it is submitted that this is not in fact the case. The Examiner's attention is directed to MPEP 201.11(I)(B), which provides as follows on MPEP page 200-59 (emphasis by underlining added):

The disclosure of a continuation application must be the same as the disclosure of the prior-filed application. See MPEP § 201.07. The disclosure of a divisional application must be the same as the disclosure of the prior-filed application, or include at least that portion of the disclosure of the prior-filed application that is germane to the invention claimed in the divisional application. See MPEP § 201.06. The disclosure of a continuation or divisional application cannot include anything which would constitute new matter if inserted in the prior-filed application. A continuation-in-part application may include matter not disclosed in the prior-filed application. See MPEP § 201.08. Only the claims of the continuation-in-part application that are disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-filed application are entitled to the benefit of the filing date of the prior-filed application. If there is a continuous chain of copending nonprovisional applications, each copending application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112, in order for the later-filed application to be entitled to the benefit of the earliest filing date.

Under 35 U.S.C. 120, a claim in a U.S. application is entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in the earlier filed application. See, e.g., *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978). A claim in a subsequently filed application that relies on a combination of prior applications may not be entitled to the benefit of an earlier filing date under 35 U.S.C. 120 since 35 U.S.C. 120 requires that the earlier filed application contain a disclosure which complies with 35 U.S.C. 112, first paragraph for each claim in the subsequently filed application. *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997).

Thus, if a continuing application that purports to be a continuation application includes something that would constitute new matter if inserted in the parent application, then the continuing application is in fact a continuation-in-part application. Here, it is submitted that copied claims 1-33 of the child Lamkin '729 would constitute new matter if inserted in the parent

Lamkin '144 because there is no support in the parent Lamkin '144 for copied claims 1-33 of the child Lamkin '729 at least because the terms "buffer," "buffer manager," "preload," "preloading," "preloaded," "preloads," "fetch signal," and "[obj].allDone API" that appear in various ones of copied claims 1, 2, 4, 5, 8-12, 14-19, 20-23, and 25-33 of the child Lamkin '729 appear only in copied claims 1, 2, 4, 5, 8-12, 14-19, 20-23, and 25-33 of the child Lamkin '729 and do not appear anywhere else in the child Lamkin '729 or anywhere at all in the parent Lamkin '144. In light of this, it is submitted that the child Lamkin '729 is actually a continuation-in-part of the parent Lamkin '144.

The Examiner's attention is directed to MPEP 201.06(c)(III), which provides as follows on MPEP page 200-25 (emphasis by underlining added):

Where a copy of the oath or declaration from a prior application was filed in a continuation or divisional application, if the examiner determines that new matter is present relative to the prior application, the examiner should so notify the applicant in the next Office action (preferably the first Office action). The examiner should require: (A) a new oath or declaration along with the surcharge set forth in 37 CFR 1.16(f); and (B) that the application be redesignated as a continuation-in-part.

Here, a copy of the declaration from the parent Lamkin '144 was filed in the child Lamkin '729. Since claims 1-33 of the child Lamkin '729 are new matter relative to the parent Lamkin '144 at least for the reasons discussed above, it is submitted that the Examiner of the child Lamkin '729 will be required to require the applicants of the child Lamkin '729 to redesignate the child Lamkin '729 as a continuation-in-part application. It is noted that the child Lamkin '729 has not yet been assigned to an Examiner.

Furthermore, it is submitted that the burden is on the Examiner of the present application, who is relying on copied claims 1-5, 7, 25, and 27-30 of the child Lamkin '729 as a reference against claims 1-7 of the present application, to determine whether copied claims 1-5, 7, 25, and 27-30 of the child Lamkin '729 are in fact entitled to the filing date of August 21, 2001, of the parent Lamkin '144 pursuant to MPEP 706.02(V), which provides as follows on MPEP page 700-23 (emphasis by underlining added):

The effective filing date of a U.S. application may be determined as follows:

...

(B) If the application is a continuation-in-part of an earlier U.S. application or international application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application.

Here, since copied claims 1-33 of the child Lamkin '729 would constitute new matter if inserted in the parent Lamkin '144 at least for the reasons discussed above, it is submitted that copied claims 1-33 of the child Lamkin '729, which include copied claims 1-5, 7, 25, and 27-30 of the child Lamkin '729 relied on by the Examiner in the rejection of claims 1-7 of the present application over the child Lamkin '729, are not supported by the parent Lamkin '144, and thus have an effective filing date that is the filing date of the child Lamkin '729, i.e., July 12, 2005, which is after the filing date of October 16, 2003, of the present application, such that copied claims 1-5, 7, 25, and 27-30 of the child Lamkin '729 cannot be used as a reference against claims 1-7 of the present application. Should the Examiner disagree, it is respectfully requested that the Examiner explain in detail why he considers copied claims 1-5, 7, 25, and 27-30 of the child Lamkin '729 to be supported by the parent Lamkin '144 in light of the detailed arguments presented above in which the applicants have pointed out why there is no such support.

Furthermore, the Examiner's attention is directed to MPEP 2304.02(d), which provides as follows on MPEP page 2300-25 (emphasis by underlining added):

An applicant is not entitled to an interference simply because applicant wants one. The interfering claim must be allowable, particularly with respect to the written description supporting the interfering claim.

Historically, an applicant provoked an interference by copying a claim from its opponent. The problem this practice created was that differences in the underlying disclosures might leave the claim allowable to one party, but not to the other; or despite identical claim language differences in the disclosures might require that the claims be construed differently.

Rather than copy a claim literally, the better practice is to add (or amend to create) a fully supported claim and then explain why, despite any apparent differences, the claims define the same invention. 37 CFR 41.203(a). The problem of inadequate written description in claims added or amended to provoke an interference is so great that the issue has been singled out for



heightened scrutiny early in the course of an interference. 37 CFR 41.201, under "Threshold issue."

Title 37 CFR 41.201 referred in the above passage reads as follows:

*Threshold issue* means an issue that, if resolved in favor of the movant, would deprive the opponent of standing in the interference. Threshold issues may include:

(1) No interference-in-fact, and

(2) In the case of an involved application claim first made after the publication of the movant's application or issuance of the movant's patent:

(i) Repose under 35 U.S.C. 135(b) in view of the movant's patent or published application, or

(ii) Unpatentability for lack of written description under 35 U. S.C. 112(1) of an involved application claim where the applicant suggested, or could have suggested, an interference under § 41.202(a).

Here, it is submitted that copied claims 1-33 of the child Lamkin '729, which include copied claims 1-5, 7, 25, and 27-30 of the child Lamkin '729 relied on by the Examiner in the rejection of claims 1-7 of the present application over the child Lamkin '729, are not supported by the underlying disclosure of the child Lamkin '729 (i.e., the abstract, the specification, and the drawings of the child Lamkin '729) in the manner required by 35 USC 112, first paragraph, at least for the reasons discussed above, such that copied claims 1-33 of the child Lamkin '729 are unpatentable to the applicants of the child Lamkin '729 under 35 USC 112, first paragraph, for lack of written description.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-7 under 35 USC 102(e) as being anticipated by various ones of claims 1-5, 7, 25, and 27-30 of Lamkin '729 be withdrawn.

#### Claim Rejections Under 35 USC 103

Claims 1-7 were rejected under 35 USC 103(a) as being unpatentable over Landsman et al. (Landsman) (U.S. Patent No. 6,466,967) in view of Silberschatz, Avi, Peter Galvin and Greg Gagne (Silberschatz) ("Applied Operating System Concepts," First Edition, John Wiley & Sons, Inc., 2000, pp. 65-66 and 412-431). This rejection is respectfully traversed.

Claim 1

It is submitted that Landsman and Silberschatz do not disclose or suggest "a markup document which was provided to reproduce the AV data in an interactive mode" as recited in independent claim 1. The Examiner considers column 9, lines 23-55; column 10, lines 5-31; and column 26, lines 43-49, of Landsman to disclose this feature of claim 1, although the Examiner did not indicate which features discussed in these portions of Landsman allegedly correspond to the "markup document" and the "interactive mode" recited in claim 1.

However, it is submitted that the only feature in the portions of Landsman relied on by the Examiner that may arguably be considered to correspond to the "markup document" recited in claim 1 is the HTML tag which is embedded into a referring page as described in column 10, lines 5-8, of Landsman. This HTML tag contains a component that downloads a Java applet that in turn downloads advertising files (media and player files) and plays the files on an interstitial basis in response to a user click-stream, that is, when the user clicks a mouse to transition to a next successive content page. See column 10, lines 5-20 and 45-53, of Landsman. The other component is the web address of an advertising management system from which the advertising files are to be downloaded. See column 10, lines 20-23, of Landsman. However, it is submitted that Landsman's advertising files are not reproduced "in an interactive mode" as recited in claim 1 because the user has no control over which advertising files will be reproduced or when a particular advertising file will be reproduced. In fact, until the first advertising file is reproduced when the user clicks a mouse to transition to a next successive content page, the user will not even be aware that any advertising files have been downloaded because this process is transparent to the user as described in column 10, lines 13-18 and 40-45, of Landsman.

The above arguments were also presented on page 13 of the Amendment of March 9, 2007. In response to these arguments, the Examiner states as follows on pages 2 and 3 of the Office Action of June 5, 2007:

With respect to the claimed markup document, Landsman teaches supplying advertisements as HTML files [col. 5 lines 53 – 55; col. 7 line 29; col. 9 line 24]. Landsman teaches a different way of delivering and presenting the advertisements than the identified prior art, but it appears that HTML is an obvious format to use.

With respect to the claimed interactive mode, Landsman teaches the advertisements are presented based on a user's actions [col. 10 lines 17 – 20].

However, column 5, lines 53-55, and column 7, line 29, of Landsman referred to by the Examiner describe prior-art methods in which advertising HTML files are embedded in a web page. Column 9, line 24, of Landsman referred to by the Examiner, which relates to Landsman's invention, states that "this new technique should preferably not embed advertising HTML files within a web page" (emphasis added). In light of this, it is submitted that there is no support whatsoever in Landsman for the Examiner's statement that "it appears that HTML is an obvious format to use" since the Examiner's statement contradicts the express disclosure in column 9, line 24, of Landsman referred to by the Examiner. Furthermore, it is submitted that nothing whatsoever in Landsman discloses or suggests that the "advertising HTML files" disclosed in Landsman and referred to by the Examiner are "a markup document which was provided to reproduce the AV data in an interactive mode" as recited in claim 1. It is submitted that the mere fact that a document is an HTML document does not make that document "a markup document which was provided to reproduce the AV data in an interactive mode" as recited in claim 1.

Landsman's apparatus implements an AdController agent 420 comprising a Transition Sensor applet 422 and an AdController applet 424 shown in FIG. 5 of Landsman that are implemented through appropriate Java classes and collectively persist, through storage in a browser disk cache 430 shown in FIG. 5, across different content pages within a site, different web sites, and successive browser sessions as described in column 23, lines 4-8, of Landsman. Column 24, lines 16-22, of Landsman describe the AdController agent as follows:

Thus, the agent persists and functions transparently in background, independent and transparent to user navigation across pages on a common web site and across web sites. In that regard, the agent effectively implements a background process which runs in parallel with and is transparent to normal HTML and HTTP operations implemented by the client browser.

It is not understood how Landsman's AdController agent 420, which "functions transparently in background, independent and transparent to user navigation across pages on a common web site and across web sites" as described in this portion of Landsman, can be considered to provide "a markup document which was provided to reproduce the AV data in an interactive mode" as recited in claim 1. It is not understood how the Transition Sensor applet

422 and AdController applet 424 included in the AdController agent 420 can be considered to be such a markup document. The AdController agent 420 downloads AdDescriptor files as shown in FIG. 5 of Landsman, which are described as follows in column 21, lines 32-48, of Landsman:

To digress slightly, for the selected advertisement, the AdDescriptor file is a text file that contains a manifest, i.e., a list, of file names and corresponding network locations (URLs) at which these files reside, and player instructions and configuration parameter values necessary to play the entire advertisement through web browser 7 to the user. FIG. 20 shows contents of typical AdDescriptor file 2000 for a PointCast Java advertisement. Specifically and as shown in section 4C of file 2000, this AdDescriptor file lists file names with partial addresses on the ad management system of all media files that constitute content for that advertisement, and, in section 1 of this file, all Java player files necessary to play all the media files. This file also respectively specifies, here shown in section 3 and 4B, an order in which the various media files are to be played, and various configuration parameters need to properly configure the operation of each player to play each corresponding media file.

It is not understood how the AdDescriptor files or the files listed in the AdDescriptor files can be considered to be "a markup document which was provided to reproduce the AV data in an interactive mode" as recited in claim 1.

With respect to the Examiner's statement that "Landsman teaches the advertisements are presented based on a user's actions," the applicants already addressed this point in the arguments on page 13 of the Amendment of March 9, 2007, where the applicants state as follows:

However, it is submitted that Landsman's advertising files are not reproduced "in an interactive mode" as recited in claim 1 because the user has no control over which advertising files will be reproduced or when a particular advertising file will be reproduced.

In fact, until the first advertising file is reproduced when the user clicks a mouse to transition to a next successive content page, the user will not even be aware that any advertising files have been downloaded because this process is transparent to the user as described in column 10, lines 13-18 and 40-45, of Landsman.

However, the Examiner did not take note of these arguments and answer the substance of them in the Office Action of June 5, 2007, as required by MPEP 707.07(f).

Furthermore, it is submitted that Landsman and Silberschatz do not disclose or suggest "control information which was provided to identify buffering state information of the markup document to be preloaded" as recited in claim 1. The Examiner considers column 34, line 66, through column 35, line 18, of Landsman to disclose this feature, except that the Examiner recognizes that "Landsman fails to specifically state that buffering state information is identified by control information." However, the Examiner is of the opinion that it would have been obvious to implement this feature in Landsman's system because column 26, lines 43-49, of Landsman "teaches that the advertisement can not be played until after it is cached . . . , motivating one of ordinary skill in the art to provide a way to determine if it is cached." The Examiner has relied on page 427, #6-8, of Silberschatz for a general teaching of outputting state information of a buffer.

However, Landsman already provides a way if determining whether an advertisement is fully cached—by loading an ad descriptor file 645 for an advertisement into a play queue 1470 after a browser cache proxy 1450 has finished downloading all media and player files for that advertisement from an agent server 15 as shown in FIG. 14 and described in column 36, lines 31-47, of Landsman. In light of this, it is submitted that there would have been no motivation for one of ordinary skill in the art to implement "a buffer manager which . . . outputs buffering state information of the buffer in response to a report signal" as recited in claim 1 in Landsman's system as a way to determine if an advertisement is cached as proposed by the Examiner.

The above arguments were also presented on pages 13 and 14 of the Amendment of March 9, 2007. In response to these arguments, the Examiner states as follows on page 3 of the Office Action of June 5, 2007:

With respect to the claimed control information, Landsman teaches the advertisements are presented in response to a trigger if the files are fully cached (state is fully cached) [col. 26 lines 43 – 49; col. 35 lines 11 – 12]. Landsman also teaches providing information about downloading operations [col. 35 lines 3 – 6].

However, these comments by the Examiner merely discuss what Landsman discloses, and do not take note of the above arguments relating to the lack of motivation to combine Landsman and Silberschatz that were also presented in the Amendment of Mach 9, 2007, and answer the substance of them as required by MPEP 707.07(f).

Column 26, lines 43-49, of Landsman referred to by the Examiner reads as follows:

Transition Sensor events are used to trigger the play of an advertisement only if, by then, all the media and player files for that advertisement have been fully cached into browser disk cache 430. Otherwise, play of that advertisement is deferred until after all those files are cached and the advertisement is ready to be rendered and, importantly, in response to the next user-initiated transition.

Column 35, lines 11 and 12, of Landsman referred to by the Examiner reads as follows:

when to play a next advertisement fully queued in the Ad Pipeline

Column 35, lines 3-6, of Landsman referred to by the Examiner reads as follows:

In particular, the Ad Loader API provides information regarding and, through setting various program variables, permits programmer control over advertisement display and downloading operations.

However, it is not seen where any of these portions of Landsman disclose or suggest "control information which was provided to identify buffering state information of the markup document to be preloaded" as recited in claim 1. Nor has the Examiner explained why he considers these portions to disclose or suggest this feature of claim 1, either alone or in combination with Silberschatz's general teaching of outputting state information of a buffer.

### Claim 3

It is submitted that Landsman and Silberschatz do not disclose or suggest the feature "wherein the control information includes an [obj].isCached(URL, resType) API that generates a report signal, where the URL is a parameter indicating a file path of the markup document and the resType is a parameter indicating an attribute of the markup document" recited in dependent claim 3. The Examiner considers column 12, lines 15-38; column 26, lines 43-49; and column 34, line 66, through column 35, line 18, of Landsman, and perhaps page 427, #6-8, of Silberschatz, to disclose this feature of claim 3. However, it is not seen where these portions of Landsman and Silberschatz disclose or suggest "an [obj].isCached(URL, resType) API" as recited in claim 3. Nor has the Examiner explained why he considers these portions of Landsman and Silberschatz to disclose this feature of claim 3.

The above arguments were also presented on page 14 of the Amendment of March 9, 2007. In response to these arguments, the Examiner states as follows on page 3 of the Office Action of June 5, 2007:

With respect to the API of claim 3, see the response above.  
Regarding the parameters, Landsman teaches identifying advertisements by file name (attribute) and web address [col. 12 lines 24 – 26].

Column 12, lines 24-26, of Landsman referred to by the Examiner reads as follows:

a list, of: file names and corresponding web addresses of all media files that constitute content for that advertisement

However, it is not seen where this portion of Landsman discloses or suggests "an [obj].isCached(URL, resType) API" as recited in claim 3. Nor has the Examiner explained why he considers this portion of Landsman to disclose or suggest this feature of claim 3.

#### Conclusion

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-7 (i.e., claims 1 and 3 discussed above and claims 2 and 4-7 depending from claim 1) under 35 USC 103(a) as being unpatentable over Landsman in view of Silberschatz be withdrawn.

#### Patentability of New Dependent Claims 8 and 9

It is submitted that Lamkin '729, Landsman, and Silberschatz do not disclose or suggest the feature "wherein the AV data is AV data that was selected by a user to be viewed by the user while being reproduced in the interactive mode" recited in new dependent claim 8. With respect to Landsman, the AV data that is reproduced in an advertisement that is displayed when the user clicks a mouse to transition to a next successive content page was not selected by the user, but was downloaded without the knowledge of the user. The user has no control whatsoever over what AV data is downloaded for reproduction in the advertisements.

It is submitted that Lamkin '729, Landsman, and Silberschatz do not disclose or suggest the feature "wherein the interactive mode is an interactive mode that was selected by a user who will view the AV data in the interactive mode" recited in new dependent claim 9. With respect to

Landsman, the mode of operation in which an advertisement is displayed when the user clicks a mouse to transition to a next successive content page was not selected by the user who will view the advertisement, but was selected by the AdController agent 420 that was implemented without the knowledge of the user. The user has no control whatsoever over the implementation of the AdController agent 420.

For at least the foregoing reasons, it is submitted that new claims 8 and 9 are patentable over Lamkin '729, Landsman, and Silberschatz, and it is respectfully requested that new claims 8 and 9 be allowed.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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